



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,485	01/23/2004	Eric J. Ruff	2916-5950US ()	7029
24247	7590	02/06/2009	EXAMINER	
TRASK BRITT			CHIN, PAUL T	
P.O. BOX 2550				
SALT LAKE CITY, UT 84110				
			ART UNIT	PAPER NUMBER
			3652	
			NOTIFICATION DATE	DELIVERY MODE
			02/06/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTOMail@traskbritt.com

Office Action Summary	Application No. 10/763,485	Applicant(s) RUFF ET AL.	
	Examiner PAUL T. CHIN	Art Unit 3652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10,18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,2,4,5,8,9,18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mark (6,238,120) (see PTO-892) in view of Kremer et al. (4,685,820) or Bob et al. (6,637,967).

Mark (6,238,120) discloses a tool comprising a body (23) having a chamber, a grasping element, a liquid adhesive (24) (Col. 1, lines 8-15), having an end of the body and an end for adhesion, a tip (15,17,20) (see Fig. 5) movable within the chamber, a plunger (37) (Fig. 7), and an interior fixed element (figs. 7 and 8) to limit the tip movement, but does not clearly show the grasping element having a semisolid material. However, Kremer et al. (4,685,820) teaches a semi-solid material such as glue, gel, or others provided (last paragraph of col. 9) on the applicator (14). Bob et al. (6,637,967) also teaches a semi-solid material on the applicator (1st paragraph of col. 11). Accordingly, it would have been obvious to those skilled in the art to provide a semi-solid material on the Mark (6,238,120) as taught by Kremer et al. (4,685,820) or Bob et al. (6,637,967) to smooth apply.

Re claim 4, figures 7 and 8 of Mark (6,238,120) show a tip secured in the body and tube wherein the tip could be differently positioned biased by a spring (13).

Art Unit: 3652

Re claim 5, figures 7 and 8 of Mark (6,238,120) show a tip-engagement element body and a body-engagement element includes a thread.

Re claim 9, figures 7 and 8 of Mark (6,238,120) of show an interior fixed element to limit the tip.

3. Claims 6,7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mark (6,238,120) and Kremer et al. (4,685,820) or Bob et al. (6,637,967), as applied to claims 1-4, and further in view of Otake (5,388,726) (see PTO-892).

The modified Mark (6,238,120), as presented above, does not show a cap to cover.

However, Otake (5,388,726) teaches a cap (3) to cover the tip. Accordingly, it would have been obvious to those skilled in the art to provide a cap on the lower end of Mark (6,238,120) as taught by Otake (5,388,726) to secure the tip from damaging.

4. Claims 1, 2, 4-10, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seymour et al. (6,293,431) in view of Kremer et al. (4,685,820) or Bob et al. (6,637,967).

Seymour et al. (6,293,431) discloses a tool comprising a body (Figs. 2A-2C) having a chamber, a grasping element, a sealing compound, having an end of the body and an end for adhesion, a tip (Figs. 1A-1C and 4) movable within the chamber, a plunger (5), and an interior fixed element (figs. 1 and 2) to limit the tip movement, but does not clearly show the grasping element having a semisolid material. However, Kremer et al. (4,685,820) teaches a semi-solid material such as glue, gel, or others provided (last paragraph of col. 9) on the applicator (14). Bob et al. (6,637,967) also teaches a semi-solid material on the applicator (1st paragraph of col. 11). Accordingly, it would have been obvious to those skilled in the art to provide a semi-solid material on the Mark

Art Unit: 3652

(6,238,120) as taught by Seymour et al. (6,293,431) as taught by Kremer et al.

(4,685,820) or Bob et al. (6,637,967) to smooth apply.

Re claim 4, figures 1 and 2 of Seymour et al. (6,293,431) show a tip secured in the body and tube wherein the tip could be differently positioned biased by a spring (13).

Re claim 5, figures 7 and 8 of Seymour et al. (6,293,431) show a tip-engagement element body and a body-engagement element includes a thread.

Re claims 6,7, and 10, figures 1A-1C of Seymour et al. (6,293,431) show a cap.

Re claim 9, figures 1A-1C of s Seymour et al. (6,293,431) show an interior fixed element to limit the tip.

Response to Arguments

5. Applicant's arguments filed Nov 12, 2008, have been fully considered but they are not persuasive.

Mark, or Seymour, Kremer, and Bob

Applicant basically argues that "none of Mark, Kremer, and Bob teaches or suggests a semisolid material that remains associated with a device protruding from a tip thereof to provide a grasping element". The arguments are not persuasive.

Claims 1 and 18 recite "a grasping element comprising a non-flowing semisolid material". It is pointed out that application does not disclose "the specific viscosity of a liquid", "the temperature of a material", "the specific softness of the material", "the position of the material", and so forth, and the recitation of "a non-flowing semisolid material" is broad. Kremer et al. (4,685,820) teaches a semi-solid material such as glue, gel, or others provided (last paragraph of col. 9) on the applicator (14). Bob et al. (6,637,967) also teaches a semi-solid material on the applicator (1st paragraph of col.

Art Unit: 3652

11), which are a substantially non-flowing semi-solid material depending on the application.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL T. CHIN whose telephone number is (571) 272-6922. The examiner can normally be reached on MON-THURS (7:30 -6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saul Rodriguez can be reached on (571) 272-7097. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3652

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PAUL T. CHIN/

Primary Examiner, Art Unit 3652